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# In the Supreme Court
OF THE
# United States

OCTOBER TERM, 1976

## No. 76-297

LEE A. TURZILLO, and LEE TURZILLO
CONTRACTING COMPANY,
*Petitioners,*

vs.

P & Z MERGENTIME,
*Respondent.*

**On Petition for Writ of Certiorari to the Supreme Court of the United States**

## BRIEF FOR RESPONDENT IN OPPOSITION

THOMAS F. SMEGAL, JR.
CHARLES E. TOWNSEND, JR.
STEPHEN S. TOWNSEND
TOWNSEND AND TOWNSEND
Steuart Street Tower
One Market Plaza
San Francisco, California 94105
Telephone: (415) 543-9600

EDWARD F. MCKIE, JR.
SCHUYLER, BIRCH, SWINDLER,
MCKIE & BECKETT
One Thousand Connecticut Avenue NW
Washington, D. C. 20036
Telephone: (202) 296-5500
*Attorneys for Respondent*

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PERNAU-WALSH PRINTING CO. - 562 MISSION STREET - SAN FRANCISCO, CA 94105

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## BRIEF FOR RESPONDENT IN OPPOSITION

Now comes Respondent and prays that the Court deny Petitioners' request for a Writ of Certiorari to the United States Court of Appeals for the District of Columbia Circuit to review the judgment in Causes Nos. 75-1079 and 75-1080 on the docket of that court.

### QUESTIONS PRESENTED

Petitioners suggest that the Court of Appeals decision of April 8, 1976 that vacated the District Court holding of validity with respect to Turzillo U. S. Patent 3,363,422

(hereinafter the '422 patent) presents three questions for review by this Court. As will be treated more fully hereinafter in the section entitled Argument, it is submitted that all of the Petitioners' alleged questions are specious and lacking in merit.

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## STATEMENT OF CASE

Petitioners' statement of the case is factually incorrect and/or intentionally misleading, as more completely detailed in the section entitled Argument.

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## ARGUMENT

### I. PETITIONERS' REQUEST FOR A WRIT OF CERTIORARI FAILS TO RECITE A CASE OR CONTROVERSY REVIEWABLE BY THIS COURT.

From a review of the questions raised and reasons advanced by Petitioners, it is apparent that Petitioners have not brought before this Court those portions of the decision of the Court of Appeals that (1) affirmed the District Court holding of non-infringement of the '422 patent; and (2) reversed the District Court holding of validity of U. S. Patent 3,464,216. In and of themselves, these portions of the decision of the Court of Appeals are fully and entirely dispositive of this litigation.

The three questions advanced by Petitioners and the accompanying reasons in support thereof are singularly directed to an unrelated ancillary aspect of the decision by the Court of Appeals, i.e., whether, in addition to the foregoing, the Court of Appeals properly vacated the District Court's finding of validity of the '422 patent. However, this aspect was not in any way controlling. In fact, the Court of Appeals' characterized that portion of its decision as follows (A3)*:



> "The District Court opinion is largely devoted to a discussion of the prior art and the validity of the '422 patent. We have doubts about the ruling that the '422 patent is valid but we simply vacate that ruling rather than resolve the issue of validity in this litigation since, in any event, *we are satisfied that the findings by the judge concerning noninfringement were not clearly erroneous.*" (Emphasis added).

Thus, Petitioners are now requesting this Court to merely render a non-controlling advisory opinion, clearly in contravention with Article III of the U. S. Constitution; *Muskrat v. United States,* 219 U.S. 346, 31 S.Ct. 250, 55 L.Ed.2d 246 (1911).

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### II. THE COURT OF APPEALS RECOGNIZED THAT THE DISTRICT COURT HOLDING OF VALIDITY OF THE '422 PATENT COULD NOT BE ALLOWED TO STAND, AS THE DISTRICT COURT HAD NOT CLEARLY GRAPPLED WITH THE ANTICIPATORY NATURE OF THE PRIOR ART PHARES REFERENCE.

In alleging that reviewable questions are raised by the Court of Appeals decision that vacated the District Court holding of validity of the '422 patent, Petitioners have chosen to distort the actual opinion of the Court of Appeals. Petitioners assert that an erroneous *turning point* of the Court of Appeals decision resulted from the Court's concern over Turzillo's failure to call the prior art Phares patent "to the attention of the patent examiner".

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*Reference is to the specific page of the Court of Appeals' decision as reproduced in Petitioners' Appendix.

Even a cursory reading of the articulate and succinct opinion by Judge Leventhal reveals that the Court of Appeals was perplexed by Turzillo's overt failure to advise the patent examiner of the Phares reference. For example, Judge Leventhal noted with obvious dismay the lack of a complete trial court record as to how it came about that Phares, a prior art reference known to applicant during prosecution of the application from which the '422 patent eventuated, was not brought to the attention of the patent examiner (A14), when it anticipated "at least major elements" of the '422 patent.

Yet, this did *not* form the basis for the Court of Appeals vacating the District Court holding of validity with respect to the '422 patent. In fact, Judge Leventhal specifically stated to the contrary (A14):

> ". . . we are not required at this juncture to formulate what standard for non-disclosure of pertinent prior art bars enforcement of an otherwise valid patent."

In reality, the basis for the Court of Appeals decision to vacate the District Court holding of validity of the '422 patent finds its genesis in the following paragraphs of its opinion:

> "We have doubts about the ruling that the '422 patent is valid . . ." (A3);
>
> . . . .
>
> "An appellate court is diffident in injecting itself into issues that turn on perception of the facts. But we must voice our concern over the way in which the District Judge handled the matter of the Phares patent. We are not particularly troubled by his mistake in saying that Phares does not show release of



> the driving bit in substantially centered position. Plaintiffs' brief posits that this was a slip of the pen and that the trial court said 'driving bit' when he meant to say 'valve plate.' *More importantly, the District Court has not clearly grappled with the significance of the disclosure in Phares as anticipating at least major elements of Turzillo.*" (A10) (Emphasis added);
>
> . . . .
>
> "Nor do we discern wherein he grappled with the question of whether, if one takes the method disclosed by Phares' patent as a beginning, any differences by Turzillo—accepting them as simplification and advances—were obvious vel non." (A11); and
>
> . . . .
>
> "We discern overall a continuing presumption accorded to the patent which was error insofar as it applied to Phares" (A11).

It is readily apparent that the Court of Appeals was deeply troubled by Turzillo's lack of candor and good faith in his dealing with the Patent Office during prosecution of the application from which the '422 patent eventuated, particularly in view of the standard for such conduct articulated by this Court in *Kingsland v. Dorsey,* 338 U.S. 318, 319, 70 S.Ct. 123, 124, 94 L.Ed. 123, 126 (1949); (A12). However, as clearly demonstrated *supra,* its decision to vacate the trial court's holding of validity was based entirely on its observation that the District Court had *obviously* failed to appreciate the significance of Phares as "anticipating" the '422 patent.

## III. IT IS THE WELL ESTABLISHED POLICY OF THIS COURT TO DENY CERTIORARI IN PATENT CASES EXCEPT UNDER EXCEPTIONAL CIRCUMSTANCES NOT PRESENTED BY THIS CASE.

Rule 19 of this Court declares that "A review on Writ of Certiorari is not a matter of right, but of sound judicial discretion and will be granted only where there are special and important reasons therefor". As stated by Chief Justice Vinson in his often quoted address before the American Bar Association on September 7, 1949:

> "The Supreme Court is not, and never has been, primarily concerned with the correction of errors in lower court decisions. In almost all cases within the Court's appellate jurisdiction, the petitioner has already received one appellate review of his case . . .
>
> The function of the Supreme Court is, therefore, to resolve conflicts of opinion on federal questions that have arisen among lower courts, to pass upon questions of wide import under the Constitution, laws and treaties of the United States and to exercise supervisory power over lower federal courts . . .
>
> *To remain effective the Supreme Court must continue to decide only those cases which present questions whose resolution will have immediate importance far beyond the particular facts and parties involved.*" (69 S.Ct. v, vi (1949) (Emphasis added).

The application of these principles to patent cases has resulted in a consistent policy of this Court of declining to review factual issues concerning the validity of particular patents in the absence of a direct appellate court conflict over those issues. As stated in *Universal Oil Co. v. Globe Oil Co.* 322 U.S. 471, 473 (1943):



> "Where the questions presented by the contested claims of infringement and validity are purely factual, this Court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases. Goodyear Co. v. Ray-O-Vac., 321 U.S. 275." (Supra at 473).

This case presents no compelling issues as to standards of patentability or meaning of invention. *Graham v. John Deere Co.,* 383 U.S. 1 (1966); *United States v. Adams,* 383 U.S. 39, 41 (1966).

This case presents no conflict of decision among the Circuit Courts of Appeals. *Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30, 35, 36 (1929). Petitioners suggest that the instant Court of Appeals decision is in direct conflict with the rule of other circuits as reflected by the holding of the Fifth Circuit in *Eli Lilly & Co., Inc. v. Generix Drug Sales, Inc.* (5th Cir., 1972) 460 F.2d 1096, wherein that court stated that the *Beckman* (439 F.2d 1369) mandate "does not mean an applicant must list out the full spectrum of his knowledge to establish bona fides."

However, the Phares patent was not "merely" a relevant reference of which Petitioner Turzillo had knowledge, but as recognized by Judge Leventhal in his decision for the Court of Appeals, was a prior art reference that *anticipated* at least major elements of Turzillo. Clearly Phares was more than merely a relevant reference for which Turzillo had no duty to inform the Patent Office. Thus, the decision of the Court of Appeals to vacate the District Court's holding of validity of the '422 patent is entirely consistent with the Fifth Circuit and with the mandate of the *Beckman* case.

## CONCLUSION

In short, there has been no persuasive reason presented by petitioner for this Court to deviate from its well established policy of refusing to hear issues which are merely advisory in nature and/or narrowly confined to determining the validity of a particular patent under well established principles of law.

For the reasons stated above, Respondent says that a Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

THOMAS F. SMEGAL, JR.
CHARLES E. TOWNSEND, JR.
STEPHEN S. TOWNSEND
TOWNSEND AND TOWNSEND

EDWARD F. MCKIE, JR.
SCHUYLER, BIRCH, SWINDLER,
MCKIE & BECKETT
*Attorneys for Respondent*

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